



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

Appellant(s): Corriveau et al.
Appl. No.: 09/682,176
Conf. No.: 9018
Filed: July 31, 2001
Title: METHODS OF PRODUCING TABLETED GUMS AND TABLETED GUMS
SO PRODUCED
Art Unit: 1761
Examiner: A. Corbin
Docket No.: 112703-183

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPEAL BRIEF

Sir:

Appellants submit this Appeal Brief in support of the Notice of Appeal filed on July 7, 2004. This Appeal is taken from the Final Rejection dated March 22, 2004.

I. Real Party in Interest

The real party in interest for the above-identified patent application on appeal is Wm. Wrigley Jr. Co. by virtue of an Assignment dated September 17, 2001 and recorded at the United States Patent and Trademark Office at reel 012223, frame 0347.

II. Related Appeals And Interferences

Appellants, Appellant's legal representative and the Assignee of the above-identified patent application do not know of any prior or pending appeals, interferences or judicial proceedings which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision with respect to the above-identified Appeal.

III. Status of the Claims

Claims 1-26 are pending in the above-identified patent application. Claims 1-26 stand rejected. Therefore, Claims 1-26 are being appealed in this Brief. A copy of the appealed claims is attached as Appendix A.

IV. Status of the Amendments

No amendments were made in this application after the final rejection.

V. Summary of the Claimed Subject Matter

Independent Claim 1 is directed to a tableted gum (Page 3, lines 1-2) comprising a gum component including one or more rectangular shaped gum chips (Page 6, lines 5-7); and a tableting media wherein the tableting media has an average particle size that is smaller in size than the average particle size of the gum chips (Page 4, lines 28-31), the tableted gum having a non-homogeneous distribution of the gum component and the tableting media (Page 5, lines 20-23).

Independent Claim 12 covers a gum comprising a mixture of rectangular gum chips (Page 6, lines 5-7) and tableting media in a tableted form (Page 4, lines 26-28), the gum having a non-homogeneous distribution of the gum chips and tableting media (Page 5, lines 20-23), and wherein the gum chips have an average particle size greater than the average particle size of the tableting media (Page 4, lines 28-31).

Independent Claim 15 covers a method of producing a tableted gum comprising providing a gum component (Page 7, line 30 – Page 8, line 20), processing the gum component to form one or more rectangular shaped gum chips (Page 8, lines 24-26; Page 6, lines 5-7), mixing the gum chips with a tableting media wherein the tableting media has an average particle size that is smaller in size than the average particle size of the gum chips (Page 6, line 27- Page 7, line 2; Page 5, lines 20-23), and processing the mixture of gum chips and tableting media to form a non-homogeneous distribution of the gum component and the tableting media in the tableted gum (Page 7, lines 8-14).

The claimed compositions often require less force or pressure in order to process the gum chip and tableting media into a tablet as compared to homogeneous mixtures (Page 3, lines 5-8) and can result in less sticking of the mixture top the surface of tableting process equipment (Page 5, lines 23-28).

Although specification citations are given in accordance with C.F.R. 1.192(c), these reference numerals and citations are merely examples of where support may be found in the specification for the terms used in this section of the brief. There is no intention to suggest in anyway that the terms of the claims are limited to the examples in the specification. Although as

demonstrated by the references numerals and citations above, the claims are fully supported by the specification as required by law, it is improper under the law to read limitations from the specification into the claims. Pointing out specification support for the claim terminology as is done here to comply with rule 1.192(c) does not in any way limit the scope of the claims to those examples from which they find support.

VI. Grounds of Rejection to be Reviewed on Appeal

1. Claims 1-7, 9-15, 17, 18, and 21-26 stand rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 4,753,805 (“*Cherukuri*”).
2. Claims 1-26 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Ream* in view of *Cherukuri* or U.S. Patent No. 6,322,828 (“*Athanikar*”).
3. Claims 8, 16, 19, and 20 stand rejected under 35 U.S.C. §103(a) as unpatentable over *Cherukuri* in view of U.S. Patent No. 5,318,784 (“*Ream*”).

VII. Argument

A. Legal Standards

35 U.S.C. §103(a) states that:

A patent may not be obtained.... if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

In making a determination that an invention is obvious, the Patent Office has the initial burden of establishing a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S. P.Q.2d 1955, 1956 (Fed. Cir. 1993). “If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of the patent.” *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference or references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or

to combine reference teachings. *In re Fine*, 837 F.2d 1071, 5, U.S.P.Q.2d 1596 (Fed. Cir. 1988). Second there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986) Finally, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q., 580 (CCPA 1974).

Further, the Federal Circuit has held that it is “impermissible to use the claimed invention as an instruction manual or ‘template’ to piece together the teachings of the prior art so that the claimed invention is rendered obvious.” *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992). “One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention” *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Moreover, the Federal Circuit has held that “obvious to try” is not the proper standard under 35 U.S.C. §103. *Ex parte Goldgaber*, 41 U.S.P.Q.2d 1172, 1177 (Fed. Cir. 1996). “An-obvious-to-try situation exists when a general disclosure may pique the scientist curiosity, such that further investigation might be done as a result of the disclosure, but the disclosure itself does not contain a sufficient teaching of how to obtain the desired result, or that the claim result would be obtained if certain directions were pursued.” *In re Eli Lilly and Co.*, 14 U.S.P.Q.2d 1741, 1743 (Fed. Cir. 1990).

In the present case, the Office action has failed to establish a *prima facie* case of obviousness in each rejection because the cited references fail to teach or suggest every element of the claimed invention, and there is no teaching or suggestion within the references cited or within the general knowledge of those skilled in the art that would have led one skilled in the art to make the combination suggested.

B. The Rejection of Claims 1-7, 9-15, 17, 18, and 21-26 Under 35 U.S.C. §103(a) Over U.S. Patent No. 4,753,805 (“Cherukuri”) Should Be Reversed Because the Office Action Does Not Establish a *Prima Facie* Case of Obviousness

Claims 1-7, 9-15, 17, 18, and 21-26 were rejected under 35 U.S.C. §103(a) as being obvious over U.S. Patent No. 4,753,805 (“Cherukuri”). A copy of *Cherukuri* is attached as Exhibit B. Applicants submit that *Cherukuri* falls far short of what would be required for the present rejection to stand. With respect to independent Claims 1, 12 and 15, *Cherukuri* lacks one or more rectangular shaped gum chips (*Cherukuri* teaches grinding its chewing gum composition), *Cherukuri* lacks tableting media having an average particle size that is smaller in size than the average particle size of the gum chips (*Cherukuri* is silent as to the size of its

tableting media/compression aid relative to its ground gum particles or the tableting media size is the same as the ground gum particle size), *Cherukuri* lacks non-homogeneous distribution of the gum component and the tableting media (*Cherukuri* is silent with respect to the distribution of its gum component with respect to its tableting media/compression aid). Other than being directed to the same class of product, *Cherukuri* has virtually nothing in common with Applicants' claimed invention.

Applicants disagree with the position taken in the Office action mailed on October 20, 2003 that a non-homogeneous distribution of gum component and tableting media is obviously present in the *Cherukuri* gum since the tableting media particles are of a smaller size than the gum particles. (*i.e.*, the passage referenced in the Office action as paragraph No. 3, Paper No. 13") Applicants also disagree with the position taken in the Office action that *Cherukuri* sweeteners could be the tableting media and that powdered sweeteners are inherently smaller than the *Cherukuri* gum particles. (*i.e.*, the passage referenced in the final Office action as paragraph Nos. 3 and 7, Paper No. 7) First, the *Cherukuri* gum formulations generally contain well over 90% of the *Cherukuri* ground gum granules and only up to 5 wt.% tableting media. It is submitted that under these circumstances, for the tableting media to hold the *Cherukuri* ground gum component together in a tablet, the tableting media would have to be homogeneous with respect to its distribution within the resulting tablet. Thus, if *Cherukuri* contains any teaching at all with respect to the distribution of the gum component and tableting media, the teaching is of a homogenous distribution and is away from Applicants' claimed non-homogeneous distribution.

Moreover, Applicants submit that the position taken in the Office action that powdered sweeteners are inherently smaller than the *Cherukuri* gum particles is mistaken. In *Cherukuri* the bulk of the powdered sweeteners are included in the gum formulations prior to grinding. Thus, the sweeteners are in particles of exactly the same size as the *Cherukuri* gum particles. (*See Example V*) To establish inherency the missing descriptive matter must necessarily be present in the thing described in the reference. *In re Robertson*, 169 F.3d 743 (Fed. Cir. 1999) Because sweeteners (if considered to be the tableting media as in the Office action) are not necessarily smaller in size than the average particle size of the *Cherukuri* gum chips powdered sweeteners, inherency with respect to this limitation cannot be found vis-à-vis the *Cherukuri* sweeteners.

Thus, Applicants submit that *Cherukuri* fails to teach or suggest every (or even most) limitations of Claims 1, 12 and 15 as required to establish a *prima facie* case of obviousness and Applicants respectfully request the rejection be reversed.

C. The Rejection of Claims 1-26 Under 35 U.S.C. §103(a) Over U.S. Patent No. 5,318,784 (“*Ream*”) in View of U.S. Patent No. 4,753,805 (“*Cherukuri*”) or U.S. Patent No. 6,322,828 (“*Athanikar*”) Should Be Reversed Because the Office Action Does Not Establish a *Prima Facie* Case of Obviousness

Claims 1-26 stand rejected under 35 U.S.C. §103(a) as being unpatentable over *Ream* in view of *Cherukuri* or *Athanikar*. A copy of *Ream* is attached as Exhibit C. A copy of *Athanikar* is attached at Exhibit D.

Ream discloses a chewing gum confection composition that is pourable. One objective in *Ream* is to obtain a novel confectionary product due to the generality popularity of novel confection products. (Col. 1, lines 11-3) The pourable product is also said to have several other advantages including that it can be packaged and marketed in unique ways, such as in miniature bottles with screw-on lids and the pourable product allows a consumer to consume any amount of the composition as desired. (Col. 2, lines 5-20) With respect to independent Claims 1, 12 and 15, Applicants submit that *Ream* does not disclose a gum component including one or more rectangular shaped gum chips nor does *Ream* disclose a tableted gum composition.

Applicants submit that there is no motivation to combine the pourable confection composition of *Ream* with *Cherukuri* to make Applicants’ gum tablets. *Ream* teaches against the formation of tablets because the many advantages of pourable compositions would be lost in such a combination. *Cherukuri* provides no more reason to combine its tablet formulations with the pourable confection compositions of *Ream*. *Cherukuri* is primarily concerned with providing a chewing gum tablet composition having a higher moisture content using ground gum granules. The invention involves including a grinding aid and a compression aid in its formulations to avoid the gum sticking to various surfaces when tableting gums having moisture contents of more than 2 wt.%. The *Cherukuri* disclosure simply would not lead one of skill in the art to its combination with *Ream* which fails to address the issue of manufacturing high moisture content gum and would lead to an unworkable combination having sticking problems. In short, neither

reference provides any motivation that would lead one of skill in the art to their combination in a way that would approach the present invention.

Applicants submit that even if the combination of *Ream* with *Cherukuri* were made, the combination still would not contain all of the limitations of the claims. For example, the combination would not contain a gum component including one or more rectangular shaped gum chips, as would be required to make the invention of Claims 1, 12 or 15 obvious. Both *Ream* and *Cherukuri* discloses chipping their gum formulations prior to inclusion in the final confection product.

Similarly, *Athanikar* provides no reason for its combination with *Ream*. *Athanikar* discloses chewing gum tablets as pharmaceutical delivery agents having improved dose accuracy and uniformity. (Col. 2, lines 54-57) The *Athanikar* compositions are prepared by cooling conventional gum compositions to sufficiently cold temperatures so that they become sufficiently brittle to grind them into a uniform powder which can be mixed with pharmaceutical agents to produce uniform tableting mixtures. (Col. 4, lines 5-13) With respect to independent Claims 1, 12 and 15, Applicants submit that *Athanikar* does not disclose a gum component including one or more rectangular shaped gum chips, nor does *Athanikar* disclose or suggest a tableting media having an average particle size that is smaller in size than the average particle size of the gum chips, nor does *Athanikar* disclose or suggest a non-homogeneous distribution of the gum component and the tableting media. Rather, *Athanikar* discloses uniform tableting media. (Col. 4, lines 9-13) Thus, *Athanikar* is at least as deficient as *Cherukuri* with respect to the limitations of Claims 1, 12, and 15.

Initially, Applicants submit that there is no motivation provided in either of the references for the combination of *Athanikar* with *Ream*. As pointed out above, *Ream* is directed to novel pourable, non-homogeneous confectionery products with all of the packaging and marketing advantages of a pourable product. Moreover, the amount of the *Ream* product delivered to a consumer is variable and can be any amount of the product that is desired. This is said to be an advantage in *Ream* but is not compatible with *Athanikar* which is directed to the delivery of uniform pharmaceutical tablet gum preparations in well-defined and precise tablet dosage forms. (Col. 4, lines 9-13) Moreover, even if the references were combined, the combination would not

contain all of the limitations of Applicants' claims. Specifically, the combination would not contain a gum component including one or more rectangular shaped gum chips, as would be required to make the invention of Claims 1, 12 or 15 obvious.

In summary the Office action has failed to establish a *prima facie* case of obviousness because *Ream* in view of *Cherukuri* or *Athanikar* fails to teach or suggest every element of the invention of independent Claims 1, 12 and 15, and there is no teaching or suggestion within the references cited or within the general knowledge of those skilled in the art that would have led one skilled in the art to make the combination suggested. Therefore, Applicants respectfully request that the rejection be reversed.

D. The Rejection of Claims 8, 16, 19, and 20 under 35 U.S.C. §103(a) over *Cherukuri* in view of *Ream* Should Be Reversed Because the Office Action Does Not Establish a *Prima Facie* Case of Obviousness.

Claim 8 ultimately depends from Claim 1 which Applicants submit is allowable over the combination of *Cherukuri* with *Ream* for the reasons set forth above. Claims 16, 19 and 20 ultimately depend from Claim 15 which Applicants submit is allowable over the combination of *Cherukuri* with *Ream* for the reasons set forth above. In short, there is no motivation or guidance provided as to how combine *Cherukuri* with *Ream* to obtain the present invention and even if combined, the two references together do not contain all of the limitations of base Claims 1 and 15. Accordingly, Applicants respectfully submit that the rejection of Claims 8, 16, 19 and 20 has been overcome and request withdrawal of the same.

VIII. Conclusion

Appellants' claimed invention set forth in Claims 1-26 is neither taught nor suggested by the cited references, either alone or in combination. The Patent Office has failed to establish a *prima facie* case of obviousness with respect to the rejection of the claimed invention. Accordingly, Appellants respectfully submit that the obviousness rejections are erroneous in law and in fact and should therefore be reversed by this Board.

Respectfully submitted,


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Dated: November 8, 2004

APPENDIX A
PENDING CLAIMS OF
U.S. PATENT APPLICATION SERIAL NO. 09/682,176

Claim 1 (previously presented): A tableted gum comprising:
a gum component including one or more rectangular shaped gum chips; and
a tableting media wherein the tableting media has an average particle size that is smaller in size than the average particle size of the gum chips, the tableted gum having a non-homogeneous distribution of the gum component and the tableting media.

Claim 2. (original): The tableted gum of claim 1 wherein the tableting media comprises a tableting powder.

Claim 3. (original): The tableted gum of claim 2 wherein the tableting powder is composed of particles that are smaller in size than the gum chips of the gum component.

Claim 4. (original): The tableted gum of claim 1 wherein the gum component comprises about 40% to about 60% by weight of the tableted gum.

Claim 5. (original): The tableted gum of claim 1 wherein the tableting media comprises about 40% to about 60% by weight of the tableted gum.

Claim 6. (original): The tableted gum of claim 1 wherein the gum component comprises about 40% by weight of the tableted gum and the tableting media comprises about 60% by weight of the tableted gum.

Claim 7. (original): The tableted gum of claim 6 wherein the tableted gum comprises a top portion which contains a substantial amount of the gum chips of the gum component.

Claim 8. (previously presented) The tableted gum of claim 7 wherein the tableting media comprises a tableting powder, the gum chips being differently colored than the tableting powder.

Claim 9. (original): The tableted gum of claim 1 further comprising a food grade lubricant.

Claim 10. (original): The tableted gum of claim 9 wherein the food grade lubricant is selected from the group consisting of magnesium stearate, calcium stearate, stearic acid, carboxy methyl cellulose and mixtures thereof.

Claim 11. (original): The tableted gum of claim 1 wherein the tableted gum comprises a sugar tableted gum or a sugar free tableted gum.

Claim 12 (currently amended): A gum comprising a mixture of rectangular gum chips and tableting media in a tableted form, the gum having a non-homogeneous distribution of the gum chips and tableting media, and wherein the gum chips have an average particle size greater than the average particle size of the tableting media.

Claim 13. (original): The gum of claim 12 wherein the average particle size of the gum chips ranges from about 0.5 mm to about 6.0 mm.

Claim 14. (original): The gum of claim 12 wherein the gum chips comprise about 40% to about 60% by weight of the tableted gum and the tableting media comprises about 40% to about 60% by weight of the tableted gum.

Claim 15 (previously presented): A method of producing a tableted gum comprising the steps of:

- providing a gum component;
- processing the gum component to form one or more rectangular shaped gum chips;
- mixing the gum chips with a tableting media wherein the tableting media has an average particle size that is smaller in size than the average particle size of the gum chips; and

processing the mixture of gum chips and tableting media to form a non-homogeneous distribution of the gum component and the tableting media in the tableted gum.

Claim 16. (original): The method of claim 15 wherein the gum component is chilled prior to forming the gum chips.

Claim 17. (original): The method of claim 15 wherein the mixture of gum chips and tableting media is punched or pressed to form the tableted gum.

Claim 18. (original): The method of claim 17 wherein the tableted gum comprises a top portion that is concentrated with the gum chips of the gum component.

Claim 19. (original): The method of claim 18 wherein the gum component comprises a different color than the tableting media.

Claim 20. (original): The method of claim 18 wherein the gum component and the tableting media have a same or similar color.

Claim 21. (original): The method of claim 15 wherein the mixture of gum chips and tableting media includes a food grade lubricant to facilitate forming the tableted gum.

Claim 22. (original): The method of claim 21 wherein the food grade lubricant is selected from the group consisting of magnesium stearate, calcium stearate, stearic acid, carboxy methyl cellulose and combinations thereof.

Claim 23. (original): The method of claim 22 wherein the food grade lubricant comprises magnesium stearate ranging from about 10% or less by weight of the tableting media.

Claim 24. (original): The method of claim 15 wherein the gum component comprises about 40% to about 60% by weight of the tableted gum and the tableting media comprises about 40% to about 60% by weight of the tableted gum.

Claim 25. (original): The method of claim 24 wherein the gum component comprises about 40% by weight of the tableted gum and the tableting media comprises about 60% by weight of the tableted gum.

Claim 26. (original): The method of claim 15 wherein the gum chips have an average particle size that ranges from about 0.5 mm to about 6.0 mm.

APPENDIX B

U.S. Patent No. 4,753,805 (“Cherukuri”)

APPENDIX C

U.S. Patent No. 5,318,784 (“*Ream*”)

APPENDIX D

U.S. Patent No. 6,322,828 (“*Athanikar*”)